

REMARKS

In the Office Action¹, the Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,948,085 to Blatter ("Blatter") in view of U.S. Patent 4,997,288 to Rosenow ("Rosenow").

Applicant has amended claims 1 and 3-17. Claims 1-17 are currently pending.

I. Regarding the rejection of claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over Blatter in view of Rosenow

Applicant respectfully traverses the rejection of claims 1-17 under 35 U.S.C. § 103(a) as unpatentable over Blatter in view of Rosenow. A *prima facie* case of obviousness has not been established with respect to these claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I),
(emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, as amended, recites:

a determining section which determines a first operation mode for performing a process in accordance with at least operating information supplied from an operating key arranged on a main body . . . after the potential detection section detects the predetermined potential, and which changes the first operation mode to a second operation mode for performing a process in accordance with the command information supplied to the serial bus terminal after the information detection section detects the command information

(emphasis added). Blatter and Rosenow, taken alone or in combination, fail to teach or suggest the claimed determination section recited in amended claim 1.

Blatter discloses an apparatus comprising “a detector coupled to [a] connector for detecting a power source on the one of the plurality of conductors and inhibiting the control signal response to detection of the power source.” (Blatter, col. 2, lines 6-10). Specifically, “to avoid possible equipment damage, an inventive safety circuit 200 is employed. Safety circuit 200 provides detection and protection by sensing the presence of a power supply potential on control bus 101, and in response, inhibiting coupling of control signals to the bus.” (Blatter, col. 4, lines 39-43).

The Examiner correctly states that Blatter “does not disclose the processing section which executes, subsequent to the detection of the predetermined potential by the potential detection section . . . [a] process in accordance with at least the operating information supplied from the operating key” (Office Action at p. 2). However, the Examiner states that Rosenow discloses the required claim element of execution of a process “subsequent to the detection of the predetermined potential,” the process performed “in accordance with at least operating information supplied from an operating key arranged on the body” as required by claim 1. (Office Action at pp. 2-3). The Examiner then states that “[i]t would be obvious to one having ordinary skill in the art at the time of the invention to [include] the encryption/decryption devices in the invention of Blatter in order to protect the client from network risk as taught in Rosenow.” (Office Action at p. 3). This, however, is not correct.

Applicant respectfully asserts that the Examiner has misinterpreted Blatter, as Blatter actually teaches away from the instant application, and a combination of Rosenow with Blatter in the manner proposed by the Examiner would be contrary to the teachings of Blatter and would render Blatter unsatisfactory for its intended purpose.

Amended claim 1 recites “a first operation mode for performing a process in accordance with at least operating information supplied from an operating key . . . after the potential detection section detects the predetermined potential.” Thus, a user of the instant application is not prevented from executing commands upon detection of a power supply potential. Blatter, on the other hand, in an attempt to “avoid possible equipment damage, [includes] an inventive safety circuit.” (Blatter, col. 4, lines 39-40). As noted above, “by sensing the presence of a power supply potential . . . in response, inhibit[s] coupling of control signals to the bus.” (Blatter, col. 4, lines 39-40). Furthermore, note Figure 2 of Blatter, which shows that all control signals are inhibited.

The Examiner recognized that Blatter “does not disclose the processing section which executes, subsequent to the detection of the predetermined potential by the potential detection section . . . [a] process in accordance with at least the operating information supplied from the operating key.” The lack of such disclosure is for good reason. Blatter is directed to preventing control signals from reaching the bus after sensing a power supply potential. As such, even assuming the Examiner’s characterization of Rosenow is correct, which it is not, Blatter actually teaches away from the invention as recited in the claims and there would be no motivation to combine Rosenow and Blatter in the manner suggested by the Examiner. Adding to Blatter the ability to “execute[], subsequent to the detection of the predetermined potential by the potential detection section . . . [a] process in accordance with at least the operating information supplied from the operating key” would render Blatter unsatisfactory for its intended purpose. As noted in MPEP 2143.01(V), “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification.”
MPEP 2143.01(V). As such, the rejection must be withdrawn for at least this reason.

Moreover, even assuming the references were combinable, Rosenow does not compensate for the deficiencies of Blatter. The Examiner states that Rosenow “executes . . . selected one of the encryption and decryption devices that supplied power supply see Fig. 2C item 254C, 256C in accordance with at least the operating information supplied from the operating key arranged on the body before the detection of the predetermined information see Fig. 26 item 2602 and Fig. 42 item SKEY” (Office Action at pp. 2-3). However, this is not correct.

Turning to Figure 42, Rosenow states “FIG. 42 is a flow chart of the SKEY routine. This routine performs the SKEY function. The routine outputs status of the MFK and KEK.” (Rosenow, col. 44, lines 5-7) (emphasis added). Thus, the SKEY element pointed to by the Examiner is a software routine or function. This does not constitute “an operating key arranged on a main body” as recited in amended claim 1. (emphasis added).

Furthermore, Rosenow does not teach or suggest “determin[ing] a first operation mode for performing a process in accordance with at least operating information supplied from an operating key arranged on a main body . . . after the potential detection section detects the predetermined potential, and which changes the first operation mode to a second operation mode for performing a process in accordance with the command information supplied to the serial bus terminal after the information detection section detects the command information” as recited in amended claim 1.

Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 13 and 17, while of different scope from claim 1, are also allowable over Blatter in view of Rosenow for the reasons set forth in connection with independent claim 1.

Claims 2-12 and 14-16 depend from independent claims 1 and 13, respectively, and because both Blatter and Rosenow do not support the rejection of independent claims 1 and 13, respectively, under 35 U.S.C. § 103(a), Blatter and Rosenow also do not support the rejection of dependent claims 2-12 and 14-16, respectively.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

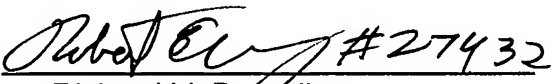
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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